

REMARKS

Claims 1-5, 8-14, 16-29, and 31-41 are pending. Claims 1-5, 8-14, 16-29, and 30-41 are rejected. Claims 6-7, 15 and 30 have been previously canceled.

Amendments to the Claims

Claims 1, 12, 20-22, 24, 28, 31, 33-34 and 39-40 are amended with merely clarifying amendments. Support for these amendments may be found throughout the specification, for example, on page 7, line 18 – page 6, line 16; (“At step 114 the user selects one of the presented delivery mechanisms... At step 116, the processor controls the sending of the data message by the selected delivery mechanism using the destination address determined at step 110”).

No new matter is added.

Claim Rejections – 35 U.S.C. § 101

The Examiner has rejected claims 28 and 40 under 35 U.S.C. § 101 as being directed to no-statutory subject matter. The Examiner asserts that these claims recite “a computer readable medium”; however this term is not used in these claims. Rather, these claims recite “An apparatus comprising: a memory; and at least one processor”. An apparatus comprising both a “memory” and a “processor” is deemed statutory subject matter.

The Applicants assert that these claims, as presently presented, overcome these rejections and respectfully request the Examiner withdraw these rejections to claims 28 and 40.

Claim Rejections - 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-5, 8-14, 16-28, 31-35 and 39-41 under 35 U.S.C. § 102(e) as anticipated by Le et al. (U.S. Patent Publication No. 2004/0072585), herein Le. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-5, 8-14, 16-28, 31-35 and 39-41.

These rejections are respectfully disagreed with, and are traversed below.

The Examiner is respectfully reminded that for a rejection to be made under 35 U.S.C. § 102(e), it is well recognized that "to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art", *Ex Parte Gould*, BPAI, 6 USPQ 2d, 1680, 1682 (1987), citing with approval *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978).

Regarding claim 1, which recites:

"A method comprising:

"in a terminal of a first party participating in a telephone call, storing, as a consequence of the telephone call, identifier data that identifies a second party participating in the telephone call;

"using the stored identifier data to determine automatically a destination address for a data message;

"**receiving a selection of a delivery mechanism; and**

"controlling a transmitter to send, during the telephone call, a data message with the automatically determined destination address, wherein said transmitter is controlled to send said data message out-of-band relative to the telephone call **using the selected delivery mechanism**" (emphasis added).

Regarding claims 21-22 the Examiner asserts: "Le teaches wherein selecting the provided option enables user selection of one of a plurality of delivery mechanisms. (the message is sent via an SMS message server, Para 27)".

Consider the disclosure of Le:

"The document US 2001/0028709 discloses a method of **sending an SMS message** more easily to the person who has attempted to call when it is not possible or desirable to take the call. The user enters a command on his keypad to choose and **send a predetermined SMS message**. The message is chosen from a set of predetermined messages stored in the terminal. The user does not have to find out the number of the recipient. The terminal identifies the person attempting to call from the caller identification data accompanying the last call received and **automatically sends the SMS message** to that number" (paragraph [0027], emphasis added).

"Enhanced Message Service (EMS) messages whose architecture is identical to that of SMS messages and enables the sending of pictures, tunes or more extensive texts, and Multimedia Message Service (MMS) messages" (paragraph [0002], emphasis added).

Le discusses various aspects of applying the described techniques to send an SMS message. Le also states that the techniques may encompass EMS and MMS messages. However, even if one would consider an EMS or an MMS as an alternative delivery

mechanism to a SMS, this does not disclose or suggest “receiving a selection” of either an SMS, EMS or MMS delivery mechanism. Rather, Le teaches to “send a predetermined SMS message”. It is unclear how the “predetermined SMS message” is disclosed as a “selection of one of a plurality of delivery mechanisms” as the message is “predetermined”.

Clearly, Le does not disclose (or suggest) “receiving a selection of a delivery mechanism” as in claim 1. Likewise, Le does not disclose or suggest “to send, during the telephone call, a data message... using the selected delivery mechanism” as in claim 1.

As Le does not disclose or suggest all elements of claim 1, Le does not anticipate claim 1. For at least this reason, claim 1 is in condition for allowance.

As claims 12, 20, 28, 33-34 and 39-40 recite similar language to that discussed above with reference to claim 1; claims 12, 20, 28, 33-34 and 39-40 are likewise in condition for allowance. Claims 2-5, 8-11, 13-14, 16-19, 21-27, 31-32, 35 and 41 depend upon claims 1, 12, 20 and 28. For at least this reason, they are likewise in condition for allowance.

The Examiner is respectfully requested to reconsider and remove the rejection under 35 U.S.C. § 102(e) based on Le, and to allow claims 1-5, 8-14, 16-28, 31-35 and 39-41.

Claim Rejection - 35 U.S.C. § 103(a)

The Examiner has rejected claims 36-38 as being unpatentable under 35 U.S.C. § 103(a) over Le in view of Paik et al. (U.S. Patent Pub. No. 2008/0153471), herein Paik. The Applicants include the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully request a favorable reconsideration of claims 36-38.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*,

the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.¹

As seen above, Le does not disclose or suggest claims 1 and 12. As claims 1 and 12 are allowable over Le then all claims that depend from claims 1 and 12 should also be allowable over Le, whether considered alone or in combination with other art cited as applied by the Examiner. Further, the addition of the disclosure of Paik to Le (without admitting that such combination is suggested or technically feasible), would not cure the deficiencies in the disclosure of Le. For at least this reason, claims 36-38 are in condition for allowance.

In light of the discussion above, the Applicants respectfully assert that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicants respectfully request that the Examiner reconsider and withdraw these rejections to claims 36-38.

Rejection of claim 29

In the Office Action Summary the Examiner indicates that "Claim(s) 1-5, 8-14, 16-29 and 31-41 is/are rejected". However, the Examiner does not provide any explanation of the rejections to claim 29 in the Detailed Action.

In the absence of any reasons of rejection, the Applicants consider claim 29 to be allowed, and respectfully requests the Examiner to confirm this status.

If the Examiner does not agree upon the allowable status of claim 29, the Applicants respectfully request the Examiner to provide a detailed explanation of the rejections to this claim in a new Non-Final Office Action.

For the foregoing reasons, the Applicants believe that each and every issue raised by the

¹ *In Re Fine*, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

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Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

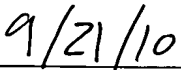
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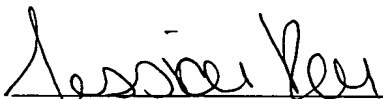
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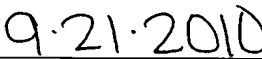
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